UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,516	02/13/2007	Maxime Goeke	90500-000072/US	6385

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EXAMINER
STRONCZER, RYAN S

ART UNIT	PAPER NUMBER
2425	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
	10/561,516	GOEKE ET AL.
Office Action Summary	Examiner	Art Unit	
	Ryan Stronczer	2425	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _11 July 2008_.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _20-40_ is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) _20-40_ is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on _13 February 2007_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☒ None of:
      1.☒ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____ .

U.S. Patent and Trademark Office
PTOL-326 (Rev. 08-06)   Office Action Summary   Part of Paper No./Mail Date 20081030

DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Switzerland on 20 June 2003. It is noted, however, that applicant has not filed a certified copy of the 2003 1082/03 application as required by 35 U.S.C. 119(b).

Election/Restrictions

Applicant's arguments, see pages 7-8, filed 11 July 2008, with respect to the restriction requirement have been fully considered and are persuasive. The restriction requirement of claims 20-25 and 26-40 has been withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 25 recites the limitation "wherein said reception means receive a command from said security module, acting on the content of said counter." There is insufficient antecedent basis for this limitation in the claim. The recited "said reception means" are not previously recited in the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 20-25 are rejected under 35 U.S.C. 102(b) as being anticipated by

Tsuria (US Pat. No.: 6,405,369).

As to claim 20, Tsuria teaches a Pay-TV decoder which is uniquely associated to

a smart card for decoding scramble Pay-TV data. Tsuria teaches the recited decoder

for processing Pay-TV data *(Fig. 1 decoders 10 and 14)*, this decoder being associated

to at least one removable security module *(smart cards 18 and 22)* by means of

identification data contained in said decoder and in the security module *(Tsuria teaches*

that the decoder stores 'chaining information' as well as a deactivation date for its

associated smart card), this decoder including a descrambling module *(decoder*

processor 26), wherein the decoder furthermore includes means to deactivate the

processing of Pay-TV data *("If one of the smart cards becomes invalid, the key…does*

not decode the [Pay-TV] transmission and access to the [Pay-TV] transmissions is

denied" (col. 5-6/lines 66-2)) as well as a counter acting on said deactivation means

according to its content *(The chaining data and deactivation date are equivalent to the*

recited counter).

As to claim 21, Tsuria teaches:

> the chaining data may include a signature, a key, or a seed which may be
> employed to...validate, identify, verify, and authenticate the second smart card.
> Preferably, the chaining data also includes a digital representation of a time
> increment which may be employed to calculate a deactivation date...The
> signature is checked and compared for validity in a decoder processor which
> forms part of the first decoder. (col. 7/lines 44-53)

As to claim 22 and 24, the recited counter is equivalent to the chaining data and

deactivation date stored by the decoder of Tsuria. Tsuria teaches that the chaining data

stored in the decoder is used to validate the associate smart card before the content is

decoded or a new deactivation date is assigned to the smart card (col. 7/lines 44-50).

The comparison taught by Tsuria is equivalent to the "command acting on the content of

said counter" recited in claim 24.

As to claim 23, Tsuria teaches that the decoder and associated smart card store

a deactivation date indicating when the smart card is no longer valid.

As to claim 25, the decoder must inherently receive the decoding information

from the smart card in order to properly descramble the incoming Pay-TV data.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 26-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuria et al. as applied to claim 20, above, and further in view of LeBerre et al. (US pat. No.: 5,748,732).

As to claim 26, the rejection of claim 20 is incorporated herein. Tsuria teaches the recited decoder and teaches coordinating between two or more decoders, but does explicitly teach designating one as a "master" decoder and the remainder as "slave" decoders, as recited. Fig. 1 of LeBerre teaches the recited a Pay-TV data management system including at least two decoders *(Fig. 1, decoders 1-3)*, wherein one of the decoders is designated as the master and the remaining are designated as the slave decoders. LeBerre further teaches that each decoder has an associated smart card which is equivalent to the recited "removable security module." As to the limitation "…wherein the decoders furthermore includes a counter that acts on said deactivation means, and in that at least one of the security modules is declared as master and includes means for reinitializing said decoder counters," LeBerre teaches that one of the decoders and associated smart cards can be designated as the "master." As to the recited "counter," the chaining data taught by Tsuria (see, e.g., col. 7/lines 28-50) is equivalent to the recited counter. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the system of LeBerre with the chaining data taught by Tsuria to ensure that a smart card is uniquely associated with a specific decoder to prevent users from reselling activated smart cards to other users and diminishing the distributor's profits.

As to claim 30, the rejection of claim 26 is incorporated herein. LeBerre teaches

the recited steps of "determining of at least one master security module." As to the

recited "storing of the identification data of the master security module in each of the

subscriber's decoders," Tsuria teaches that the decoder memory stores the "chaining

data" and deactivation date for the smart cards. As to the recited "deactivating, by

means of the counter, of the data processing decoder according to at least one

predefined criterion, reinitializing of the counter by introducing the master security

module into the deactivated decoder," Tsuria teaches that the decoder detects when the

smart card is deactivated and disables decoding of the Pay-TV data until such time as

the deactivation data and chaining information on the second smart card is updated.

Tsuria teaches that *"[t]o reactivate the second smart card, a subscriber preferably*

removes the first [e.g., master] *smart card from...the first* [e.g., master] *decoder and*

replaces by the second [e.g., slave] *smart card"* (col. 7/lines 24-26). This renews the

deactivation date for the second smart card and reactivates service. Since the second

(slave) decoder is uniquely associated with a specific slave decoder, reactivating the

second smart card is effectively equivalent to reactivating the second decoder.

As to claims 27 and 31, Tsuria teaches,

> the chaining data may include a signature, a key, or a seed which may be
> employed to...validate, identify, verify, and authenticate the second smart card.
> Preferably, the chaining data also includes a digital representation of a time
> increment which may be employed to calculate a deactivation date...The
> signature is checked and compared for validity in a decoder processor which
> forms part of the first decoder. (col. 7/lines 44-53)

As to claims 28 and 32, Tsuria teaches that the second smart card transmits the

decoding instruction information to the second memory decoder only if *"the signatures*

of the first smart card and the second smart card coincide" (col. 8/lines 24-26). Though

Tsuria does not explicitly teach that said first decoder is designated as the "master

decoder," it would have been obvious, given the combination of LeBerre and Tsuria that

the slave smart cards would have to have matching signatures to the master smart card

to allow the slave smart card and decoder to be reactivated.

As to claim 29, LeBerre teaches that one of the smart cards is designated as the

master.

As to claim 33, LeBerre teaches that a management center communicates

renewal information for the smart cards to the master device (col. 3/line 64-col. 4/line 8).

Though LeBerre does not explicitly teach the communication of a deactivation signal, it

is implicit in LeBerre that a failure of the system to transmit the message EMM or of the

user to update the deactivation data for the smart cards will result in the deactivation of

said smart cards.

As to claims 34 and 35, Tsuria teaches, *"[a]lternatively, the new deactivation date*

is communicated, via the pay television network, to a pay television headend (not

shown), which may later use the new deactivation date to deactivate the second smart

card when the new deactivation date elapses" (col. 7/63-67). The message

communicated from the headend is equivalent to the EMM recited in claim 35. It would

have been obvious to one of ordinary skill in the art at the time of the invention that the

management center taught by LeBerre is equivalent to the recited headend.

As to claims 37 and 39, LeBerre teaches that the master smart card is registered on the management device as such, and thus the processing data stored in said master module inherently must be transmitted back to the management device.

As to claim 36, Fig. 2b of Tsuria in combination with the master/slave system taught by LeBerre teaches that when an invalid card is inserted into the decoder, the master card must also be inserted into the decoder and the chaining information verified for the inactive card to be re-activated. Tsuria further teaches that both the decoder and the smart card store chaining information and a deactivation date corresponding to the processing of Pay-TV data.

As to claims 38 and 40, LeBerre teaches that the master smart card is registered on the management device as such, and thus the processing data stored in said master module inherently must be transmitted back to the management device.

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan Stronczer whose telephone number is (571) 270-3756. The examiner can normally be reached on 7:30 AM - 5:00 PM (EDT), Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian T. Pendleton can be reached on (571) 272-7527. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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published applications may be obtained from either Private PAIR or Public PAIR.

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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